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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,552	10/29/2001	Jay F. Kunzler	P02460	8018

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 04/04/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/005,552

Applicant(s)

KUNZLER ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20 to 38 is/are pending in the application.
- 4a) Of the above claim(s) 36 to 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20 to 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.      6) ☐ Other: \_\_\_\_\_

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1. Applicant's election with traverse of Group II in Paper No. 4 is acknowledged. The traversal is on the ground(s) that search and examination of all claims should not be burdensome and that the search of Group II would be inclusive of the search for Groups I and III. This is found persuasive to the extent that the Examiner agrees that an examination and search of Groups I and II would not be an undue burden. However, she does believe that a search and examination of Group III in addition to Groups I and II would be an additional burden. Note that examination of each group extends beyond the search, and the Examiner believes that an examination of Group III would be an undue burden. For instance, the specific vinyl carbonate found on column 7, line 50, clearly anticipates claim 36, but this specific vinyl carbonate itself does not clearly anticipate claims 20 and 27. Obviously, separate examination is necessary.

Thus, to this extent, the requirement is still deemed proper and is therefore made FINAL. Currently claims 20 to 35 are under consideration.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20 to 36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kunzler et al.

Kunzler et al. teach hydrogels and contacts lenses prepared from fluorinated siloxanes and an additional hydrophilic monomer. See patentees' claims 12 and 13. See also patentees' claims 3 to 6 which teach the same hydrophilic monomers of instant

claims 21 and 24, and column 7 which teaches that the monomers of claims 22, 23 and 25 are preferred. The fluorinated siloxane in Kunzler et al. can be found as formula III on the bottom of column 3, having a fluorinated group meeting that of claim 26. As can be seen from formula III, A is an activated unsaturated group as defined on column 4, lines 10 to 18. The group A can be selected from one of seven choices, among which is a vinyl carbonate group. In view of this limited species selections, and in view of the fact that Kunzler et al. specifically show that Y can be O, resulting in a carbonate link, one having ordinary skill in the art would have immediately envisioned a terminal vinyl carbonate group from the teachings in Kunzler et al. This reference teaches a small genus which places a claimed species in the possession of the public and as such anticipates the instant claims.

On the other hand, the selection of a vinyl carbonate terminated siloxane having fluorinated side chains would have been obvious over the teachings of Kunzler et al. since patentees disclose that the siloxane therein can be terminated with such groups.

In addition to the anticipation/obviousness of the claims as the result of formula III, the Examiner also draws attention to the formulas on line 45-50 of column 7. This is a vinyl carbonate terminated siloxane meeting the formula in claim 28 when "y" and "w" are 1 and "x" is 0. Kunzler et al. teach that this silicone containing vinyl carbonate can be used in combination with the polymers of formula III to form the hydrogel and contact lens. Since Kunzler et al. suggest using this vinyl carbonate end capped siloxane, this teaching renders obvious instant claims 20, 26 to 29 and 35.

5. Claim 27 and 29 to 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nandu et al.

Nandu et al. teach silicone contact lenses. See for instance the preferred vinyl carbonate terminated siloxanes of formula III on column 3. In this formula, the R groups attached to the siloxane backbone are defined as being hydrocarbon or halogen substituted hydrocarbon. From this limited selection, one having ordinary skill in the art could immediately envision a halogen substituted side chain. For instance, in the formula on column 4, line 38, the only difference between this siloxane and that required to make

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the contact lens of claim 27 is the presence of methyl side chain groups. However, since the only alternative to such hydrocarbon groups are halogen substituted hydrocarbon groups, the skilled artisan would have anticipated the claimed invention.

On the other hand one having ordinary skill in the art would have found the use of a halogen substituted hydrocarbon in place of the hydrocarbon groups in this siloxane to have been obvious in view of their alternative use.

For the record, the Examiner notes that this rejection does not apply to claims 20 to 26 and 28 since Nandu et al. fail to suggest the R" group required by these claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-308-4334. The examiner can normally be reached on Mon., Wed., Thurs. and Friday, 10am to 4pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
April 2, 2003